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No. --------

IN THE SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1973

WOODRUFF AND SONS, INC.
and ROY J. WOODRUFF,

Petitioners,

vs.

LASER ALIGNMENT, INC. and CONTRACTORS AUTOMATED DEVICES, INC.,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

FOREWARD

Respondents cannot accept as true or accurate the "Statement of the Case" set forth in the Petition For Writ of Certiorari in this case, particularly with respect to the characterization of the patented method and the methods used by Plaintiffs and Defendants, and finds the same so distorted and misleading as to compel Respondents to set forth a more accurate statement, which follows.

STATEMENT OF THE CASE

The petition involves a patent on a method for laying sewer pipe which was held by both the Seventh Circuit Court of Appeals and the trial court to be "a valuable contribution to the [sanitary engineering] art and one that fulfilled a long-felt need" (A57).* This method in the words of the trial court, which were adopted by the court of appeals (A48-A49),

> "... was characterized by a series of steps including projecting a collimated narrow beam of light in a trench along a desired course for the pipeline and then individually positioning or stacking the sections of the pipe, seriatim, end-to-end, one after another, with their axes along this beam, the light beam being projected through the pipes and the position of each pipe being observed by sighting with a target having a translucent screen removably inserted in the end of each pipe section to extend across the pipe axis."

The Petitioners, in practicing this method, used a laser beam which, like the white light beam originally used in the practicing of the Trice method, is a " 'collimated narrow beam of light' called for by the Trice patent" (A54).

The trial court had adopted several findings of fact proposed by Petitioners and it is these findings which purportedly set down factual differentiations between the methods practiced by the Petitioners and the method claims of the patent, and thus preclude infringement. The Seventh Circuit reversed the District Court on the grounds that documentary and uncontested facts in the record clearly showed that there was no real dispute of the fact that the laser beam used by the defendants was literally a collimated narrow beam of light, as explicitly claimed in the patent. It thus found infringement by applying the sim-

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* References throughout are to the pages of the Appendix of the Petition For Writ of Certiorari.

plified, literal infringement test set forth in *Graver Tank & Mfg. Co., Inc.* v. *Linde Air Products Co.*, 339 U.S. 605 (1950). The appeal court also held that those findings of fact proposed by the Petitioners and relied on by the trial court for its holding of non-infringement were clearly erroneous.

The court of appeals, after fully considering and discussing that the doctrine of equivalents cannot be invoked if "file wrapper estoppel" is applicable, found that it could be clearly ascertained from the record that as a matter of fact the claims were infringed by Petitioners' method.

ARGUMENT

I. THIS IS AN ORDINARY PATENT CASE

It is obvious from the above "Statement of the Case" that Respondents sued Petitioners in a normal and ordinary patent case for infringement of the Trice patent referred to above. As in most patent cases, Petitioners denied the patentee had made an invention, denied the claims in suit define anything of an inventive nature over the prior art, and denied that the patent was infringed. The trial court found the patent valid but not infringed. On appeal, the Seventh Circuit Court of Appeals by an unanimous decision, and on the basis of documentary and undisputed facts in the record, resolved the disputed questions of fact in favor of the patentee and reversed the decision of the trial court. That is all there is to this case.

Petitioners would like to have another try before the Supreme Court to convince the Court that the decisions on the questions of fact as made by the circuit court of appeals are erroneous, exactly as criticized by Mr. Justice Frankfurter in *Rogers* v. *Missouri Pacific Railroad Company*, 352 U.S. 518, 542 (1957):

> "Disappointed litigants and losing lawyers like to have another go at it, and why should they not try if certiorari is granted in cases like these?"

The jurisdiction of the Supreme Court, to review judgments of the circuit courts of appeal on certiorari, is neither conferred nor exercised merely to accommodate defeated litigants who are dissatisfied with the decision of the circuit court of appeals in the ordinary run of patent cases. As this Court, by Mr. Chief Justice Taft, said in the case of *Magnum Import Co.* v. *Coty,* 262 U.S. 159, 163 (1923):

> "The jurisdiction was not conferred upon this court merely to give the defeated party in the Circuit Court of Appeals another hearing."

On the contrary, as stated by Mr. Justice Frankfurter in *Rogers, supra,* where he cited the *Magnum Import* case and also quoted from the Court's decision in *Hamilton-Brown Shoe Co.* v. *Wolf Brothers and Company,* 240 U.S. 251, 257-258 (1916):

> ". . . certiorari jurisdiction 'is a jurisdiction to be exercised sparingly, and only in cases of peculiar gravity and general importance, or in order to secure uniformity of decision' " (352 U.S. at 531).

II. PETITIONERS ARE OBVIOUSLY ATTEMPTING TO HAVE THE COURT RETRY ISSUES OF FACT

The Seventh Circuit Court of Appeals based its decision on the following two salient facts, shown by uncontradicted matters of record:

(1) "The laser beam, like the white light beam originally used in the practice of the Trice method, is a 'collimated narrow beam of light' called for by the Trice patent (A54)."

(2) ". . . those findings of the district court purporting to set down factual differentiations between the methods employed by the defendants and the Trice method claims as precluding infringement are clearly erroneous (A57)."

Despite these explicit holdings, Petitioners by making rash and misrepresenting statements in their "Statement

of the Case" are still attempting to have the Court believe that, contrary to the fact findings of the court of appeals, the method steps of the claims are specifically limited to the use of a specific type of collimated narrow beam of light and to the use of a specific target with a light shield, a mirror, and handles. Obviously this illustrates the lengths to which Petitioners are willing to go in a last ditch effort to obtain another hearing on the facts. As previously pointed out, the Court should not afford the Petitioners the opportunity of another hearing on the above issues of fact and, therefore, the petition should be denied.

III. COMMENTS ON THE QUESTIONS

A. The Issue Phrased as Question One is Strictly Academic, and Irrelevant to this Petition Since the Court of Appeals Explicitly Found Direct, Literal Infringement to be Present, Thus Obviating any Inquiry as to "Equivalence"

The holding of the Seventh Circuit on the fact issue that the use of a laser beam in the method is a "collimated narrow beam of light called for in the Trice patent", and that therefore under *Graver, supra,* "infringement is made out and that is the end of it", makes this first question academic. Therefore, it is respectfully submitted that the petition should not be granted, since it is well established that the Court will not waste its time and efforts on a purely academic question: *Thorpe* v. *Housing Authority of City of Durham,* 393 U.S. 268 (1969); *Busby* v. *Electric Utilities Employees Union,* 323 U.S. 72 (1944); *Triplett* v. *Lowell,* 297 U.S. 638 (1936), rehearing denied 298 U.S. 691 (1936).

B. The Court of Appeals Did Not Apply a Double Standard of Judgment

Although Question 1 is considered academic and therefore the Court should deny the petition on this ground alone, it is interesting to note that contrary to the Defendants' assertions, the court of appeals did not apply a double standard of judgment in reaching its conclusion, as the

Petitioners would have the Court believe. To the contrary, it is clear from the decision that the court of appeals correctly reasoned that there is no necessity to relate back to the filing date of the patent in the present case for making a determination of infringement because in determining infringement of a patent, the scope of the patented invention is defined by the claims, and the claims speak as of the date the patent is issued. It is at the issue date when the public is put on notice as to the scope of the patentee's property rights and his invention. On the other hand, for the purpose of priority a patent speaks for all it discloses as of the filing date since the disclosure of an issued patent is considered part of the prior art as of the filing date of the patent application. Therefore, in the context of priority of invention, when an inventor makes a disclosure in a patent application, he obviously made his invention at least prior to the date when he filed his disclosure as a patent application. Therefore, another inventor who makes the same invention after such filing date of the first inventor is not the first inventor and therefore should not be entitled to a patent.

C. The Court of Appeals Did Not Render a Decision which is Contrary to a Prior Decision

Nor did the court of appeals render a decision which is contrary to the legal conclusion in *American Chemical Paint Co.* v. *J. G. Brill Co.*, 99 F.2d 602 (3rd Cir. 1938). That opinion clearly holds, contrary to what is asserted by Defendants, that the critical date is the date of "the issuance of a patent" (Id. at 605). The Court should take notice that in the *American Chemical Paint Co.* case the claims in the patent did not literally read on the accused method, as they do in this case; therefore there was a classical question of equivalency in that case, but there is no such question in this case. In the *American Chemical* case, the court held that since the patent issued in 1921 and the substituted substance did not become known until 1925, there could not be an infringement because the substituted material was not known until *"after the issuance of a patent"* (Id. at 605, Emphasis Added). Therefore, there is

no actual conflict of opinion in the courts as to the meaning of the words "known at the date of the Letters Patent" and therefore there is no compelling reason for the Court to grant the petition herein requested.

D. The Court of Appeals Clearly Considered the Doctrine of "File Wrapper Estoppel", but Decided it Adversely to Petitioners

A clear reading of the decision of the Seventh Circuit Court of Appeals establishes that the court did not emasculate the doctrine of equivalents as contended by Petitioners. In fact, the court very clearly considered the doctrine of "file wrapper estoppel" and its applicability, particularly when the doctrine of equivalents is to be invoked. It fully considered, and agreed, that the doctrine of equivalents cannot be invoked to its full extent if "file wrapper estoppel" is applicable. The court followed the long-established file wrapper estoppel doctrine by considering whether or not the inventor during the prosecution of his patent application, in responding to a rejection by the Examiner, had abandoned something before the Patent Office which the assignee is now trying to recapture. The court after obviously giving careful attention to all the facts, including the prior art and the file wrapper of the patent, concluded that the Respondents were not trying to recapture that which Trice, the patentee, had given up during the prosecution of his application. The file wrapper estoppel contention of the Petitioners was not rejected on the basis that there is no such doctrine but on the basis of fact that "the claims in the patent as granted are basically a rephrasing of that which had been rejected" (A61). The Seventh Circuit holding in the present case follows the file wrapper estoppel doctrine precisely as set forth in *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U.S. 126 (1942) and in *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U.S. 211 (1940), rehearings denied 312 U.S. 654 (1941), 312 U.S. 714 (1941), as cited by the court of appeals.

CONCLUSIONS

In conclusion it is respectfully submitted that this case is an ordinary patent case which Petitioners lost because of the fact situation. The petition does not bring to the Court a question of any wide or national importance, or one in which the courts of appeals are in conflict, or which has not previously been settled. In fact, Question 1 is merely academic and Question 2 is not even presented by the court of appeals decision, since the court of appeals paid close attention to, and certainly did not ignore or emasculate the doctrine of file wrapper estoppel.

The decision of the court of appeals only affects the industry by granting to Trice, the patentee, his due reward for an invention which was found to be a valuable contribution to the art and one that fulfilled a long-felt need. The general public is the benefactor.

The decision of the court of appeals does not conflict with any other decisions. The court of appeals applied an interpretation to the patent claims which was fair and to which the patentee was entitled. Such interpretation does not enlarge the patent claims to include areas explicitly abandoned in the Patent Office. As stated by the court of appeals:

> ". . . we are convinced that we have not read them [i.e., the claims] any more liberally than their fair intendment calls for and certainly not so as to include any aspect of the method foregone during the pursuit of the patent." (A61)

It is submitted that there is nothing extraordinary in this suit to call for the extraordinary remedy of a writ of certiorari, and as normally cases involving validity and infringement of patents are finally ended when a circuit court of appeals passes thereon, it is submitted that the petition should be denied. Indeed, if the Supreme Court of the United States is to grant a petition for certiorari in patent cases under circumstances like those of the present case, it is submitted that it will be expected to do so in

every one of the many patent cases decided by the various courts of appeals each year.

On the contrary, the Court has in the past clearly shown that it will carefully and selectively exercise discretion, limiting the grant of petitions for certiorari in patent cases to those which are truly "cases of peculiar gravity," involving questions such as the patentability of computer programs *Gottschalk* v. *Benson*, 409 U.S. 63 (1972), previously undecided questions of venue in patent infringement actions for aliens having no residence or place of business in this country *Brunette Machine Works, Ltd.* v. *Kockum Ind., Inc.*, 406 U.S. 706 (1972), or serious questions of misuse or anti-trust violations *U.S.* v. *Chas. Pfizer & Co., Inc.*, 404 U.S. 548 (1972). On the contrary, petitions have not been granted in cases merely seeking still further review of such ordinary matters as file wrapper estoppel and doctrine of equivalents, even where such questions appeared bona fide and not hypothetical, academic, or even fictitious, as in the present case. See, for example, *Ford Motor Co.* v. *Ellipse Corp.*, 406 U.S. 948 (1972), rehearing denied 93 S.Ct. 99 (1972); *Unarco Industries, Inc.* v. *Swanson*, 94 S.Ct. 593 (1973); *L. Goldstein's Sons, Inc.* v. *Trio Process Corp.*, 93 S.Ct. 319 (1972); and *Lemelson* v. *Topper Corp.*, 405 U.S. 989 (1972).

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